

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHUC B. DAO, DOUGLAS S. VANBIBBER and JAMES N. MILLER

Appeal No. 1999-0645
Application No. 08/799,056¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-9 and 11-16, which are all of the claims pending in this application. In the answer (Paper No. 8), the examiner withdrew the 35 U.S.C. § 102(b) rejection of claims 1-6, 11-14 and 16 based on the Australian document (answer, page 3) and the 35 U.S.C. § 103 rejection of claims 1, 2, 7-9

¹ Application for patent filed February 10, 1997.

and 11-15 (answer, page 4) and indicated that claims 6-9, 13 and 15 contain allowable subject matter but are objected to as being dependent upon a rejected base claim. Accordingly, this appeal involves only claims 1-5, 11, 12, 14 and 16.

We REVERSE.

BACKGROUND

The appellants' invention relates to a collapsible knob assembly and to a retention spring for yieldably fixing a shaft in a cavity of a knob. An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, which appear in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Keeling, Jr. (Keeling)	3,805,637	Apr. 23, 1974
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The following rejection is before us for review.

Claims 1-5, 11, 12, 14 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Keeling.

Reference is made to the brief (Paper No. 7) and the answer (Paper No. 8) for the respective positions of the

appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims², to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001,

² We note that "the tab" in claim 12, line 4, lacks antecedent basis in the claim. We leave this to be addressed in the event of any further prosecution before the examiner.

1010 (Fed. Cir. 1991). Claim 1 recites, *inter alia*, a retention spring "surrounding the shaft" and claim 11 recites, *inter alia*, "a sheet metal spring having a body for surrounding and frictionally gripping the shaft." The examiner's position (answer, page 3) is that the Keeling retention clip (35) surrounds "(at least partially)" the shaft. It appears to us that this position is based on a misinterpretation of the term "surrounding."

The term "surround" is ordinarily and customarily understood to mean "to cause to be encircled on all or nearly all sides" or "to be present on all or nearly all sides."³ The body (26) of the appellants' disclosed retention spring (24), as best seen in Figure 4, forms a D-shaped enclosure which fully encircles or encloses the shaft (14) inserted therein and, thus, is capable of "surrounding" the shaft in the ordinary and customary usage of "surrounding." As we see it, complete, or nearly complete, enclosure is required to satisfy the "surrounding" limitation of claims 1 and 11.

³ Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

The shank (37) of the retention clip (35) of Keeling does not form an enclosure or anything even close to an enclosure and, thus, is not capable of "surrounding" a shaft, as required by independent claims 1 and 11.

Accordingly, we cannot sustain the examiner's rejection of claims 1 and 11, or claims 2-5, 12, 14 and 16 which depend therefrom, under 35 U.S.C. § 102(b).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-5, 11, 12, 14 and 16 under 35 U.S.C. § 102(b) is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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